

## CERTIFICATE OF MAILING (37 CFR 1.8(A))

PATENT

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: *3 July 2003*

Laura J. Kelly

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLN NUMBER 10/006,874	FILING DATE 14 NOV 2001	FIRST NAMED INVENTOR ELDERING	ATTY. DKT. NO. T738-10
TITLE ALTERNATIVE ADVERTISING IN PRERECORDED MEDIA		ART UNIT 2611	EXAMINER FAILE, A.

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SEP 25 2003

Technology Center: 2600  
 Attention: Special Program Examiner  
 Assistant Commissioner for Patents  
 Washington, D.C. 20231

**PETITION TO MAKE SPECIAL**  
**PURSUANT TO 37 CFR §1.102(d) and MPEP §708.02 item VIII**

*OFFICIAL*

Applicant hereby petitions the United States Patent and Trademark Office ("USPTO") to grant the above noted non-provisional application having application serial number 10/006,874, filed on November 14, 2001 special status and accordingly accelerate the processing of the application.

Applicant respectfully submits that this petition should be granted by the USPTO because the Applicant has met all of the criteria defined in MPEP §708.02 item VIII and recited below.

A. An authorization to charge the Expanse Networks deposit account, in the amount of the fee set forth by 37 C.F.R. §1.17(i) is attached herewith (see Fee Calculation Sheet).

B. Applicant submits that the claims presented in this application are directed to a single invention. In the event that the Examiner considers that the claims are not obviously directed to a single invention, the Applicant acknowledges that they will make an election without traverse.

C. The Applicant performed a pre-examination search. The search included: (1) class/subclass search; (2) keyword and company search for patents and/or patent

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application publications; and (3) keyword and company search of Infernet for publications or relevant information about companies involved in this area. The different search types were often combined (i.e., keyword and class/subclass search), and the results of one search type were often incorporated into the other search types (i.e., Internet search results providing key terms or companies were used in patent/publication search). Below are the details of each of the searches:

1. The following CLASSES/SUBCLASSES were searched on the USPTO website:

- 725/1, 32, 34, 36, 40-43, 45-47, 78, 82, 85, 86-104.
- 345/327, 716-726.
- 348/3, 6, 7, 8, 10, 12, 13, 384-440, 441-496.
- 455/2, 4, 5.
- 386/46, 125, 186.

2. A search was conducted for U.S. Patents, U.S. Patent Application Publications, and PCT/foreign Patents/Applications. The areas searched included include abstract, specification and claims. Databases used for the search included USPTO, WIPO, EPO (worldwide database), and Patent Café.

The keywords searched included at least the following terms alone and in numerous combinations of each other along with various combinations of keywords and classes/subclasses: "substitute", "alternative", "commercials", "fast-forward", "trick play", "advertise", "advertisement", "ad", "advertising", "VOD", "video on demand", "television", "TV", "PVR", "personal video recorder", "VCR functions", "skip TV programming".

The companies searched include TiVo, ReplayTV, SonicBlue, CacheVision, Keen Personal Media, NDS, Microsoft, Rearden Steel, MetaByte Networks, Jovio and GemStar.

3. The INTERNET search was performed using multiple search engines (e.g., Google, Yahoo, Metacrawler, and HotBot) and databases (e.g., IP.com). The search used the same key words and companies defined above as well as a search of technology

fields, such as ITV and digital media advertising. The results of the Internet search (i.e., key companies; key personnel, investors or other relevant information listed in company profiles) were used for further patent/patent application publication searches. Additionally, a journal, newsletter, press release, etc. search was conducted to identify any publications potentially authored by the companies or its representatives.

D. Each relevant reference is identified on the attached IDS and one copy of each reference is enclosed thereto.

**Discussion**

Below is a detailed description of each of the references and discussion of how the claimed subject matter (each independent claim) is patentable over the references:

**AA U.S. 6,070,186**

***Relevance:***

Discloses displaying advertisements during non-transmission periods (i.e., prior to play, fast-forward or skip of a video selected) instead of not displaying any material or illegible material. Does not permit the advertisements to be fast-forwarded or skipped.

***Independent claims 1, 55 and 99*** (directed to displaying alternative ad when trick play event is detected):

Specific claim elements not disclosed or suggested include: detecting the trick-play event during playback of a recorded advertisement; and displaying the alternative advertisement to the subscriber.

***Independent claim 70*** (directed to generating an alternative ad by applying processing rules to recorded ad):

Specific claim elements not disclosed or suggested include: receiving processing rules; and generating the alternative advertisement by applying the processing rules to the recorded advertisement.

*Remarks:*

Does not disclose or suggest detecting trick play events during viewing of recorded advertisements and in fact discloses that the initiation of a trickplay event (i.e., fast-forward or skip) during viewing of a commercial shall not be permitted. As such, does not disclose generating and/or displaying alternative advertisements during these events.

AB U.S. 6,208,805

*Relevance:*

Discloses videos to be adapted for viewers preferences (i.e., violence, nudity) by having multiple versions of different sections of the video with each section equating to a different viewer type. To offset the costs of this type of video commercials may be included.

*Independent claims 1, 55 and 99* (directed to displaying alternative ad when trick play event is detected):

Specific claim elements not disclosed or suggested include: detecting the trick-play event during playback of a recorded advertisement; and

displaying the alternative advertisement to the subscriber.

*Independent claim 70* (directed to generating an alternative ad by applying processing rules to recorded ad):

Specific claim elements not disclosed or suggested include: receiving processing rules; and generating the alternative advertisement by applying the processing rules to the recorded advertisement.

*Remarks:*

Does not disclose or suggest detecting trick play events during advertisements. As such, does not disclose generating and/or displaying alternative advertisements during these events.

AC U.S. 6,289,165

*Relevance:*

Discloses being able to manipulate the viewing of a particular program to skip portions, replay portions or change angles by application of commands. The commands cause the player to jump to different portions of the prerecorded media. The portions of the media may have been flagged when distributed or may be flagged by the subscriber.

*Independent claims 1, 55 and 99* (directed to displaying alternative ad when trick play event is detected):

Specific claim elements not disclosed or suggested include: detecting the trick-play event during playback of a recorded advertisement; and displaying the alternative advertisement to the subscriber.

*Independent claim 70* (directed to generating an alternative ad by applying processing rules to recorded ad):

Specific claim elements not disclosed or suggested include: receiving processing rules; and generating the alternative advertisement by applying the processing rules to the recorded advertisement.

*Remarks:*

Discloses being able to manipulate the viewing of a particular program to skip portions, replay portions or change angles by application of commands. The commands cause the player to jump to different portions of the prerecorded media. The portions of the media may have been flagged when distributed or may be flagged by the subscriber.

AD U.S. 6,304,715

*Relevance:*

Discloses videos to be adapted for viewers preferences (i.e., violence, nudity) by having multiple versions of different sections of the video with each section equating to a

different viewer type. To offset the costs of this type of video commercials may be included.

*Independent claims 1, 55 and 99* (directed to displaying alternative ad when trick play event is detected):

Specific claim elements not disclosed or suggested include: detecting the trick-play event during playback of a recorded advertisement; and  
displaying the alternative advertisement to the subscriber.

*Independent claim 70* (directed to generating an alternative ad by applying processing rules to recorded ad):

Specific claim elements not disclosed or suggested include: receiving processing rules; and generating the alternative advertisement by applying the processing rules to the recorded advertisement.

**Remarks:**

Does not disclose or suggest detecting trick play events during advertisements. As such, does not disclose generating and/or displaying alternative advertisements during these events.

**AE U.S. 6,327,418**

**Relevance:**

Discloses simultaneously recording and viewing, playing back, or fast-forwarding a single video or multiple videos. Basic description of a PVR.

*Independent claims 1, 55 and 99* (directed to displaying alternative ad when trick play event is detected):

Specific claim elements not disclosed or suggested include: detecting the trick-play event during playback of a recorded advertisement; and  
displaying the alternative advertisement to the subscriber.

*Independent claim 70* (directed to generating an alternative ad by applying processing rules to recorded ad):

Specific claim elements not disclosed or suggested include: receiving processing rules; and generating the alternative advertisement by applying the processing rules to the recorded advertisement.

*Remarks:*

Does not disclose or suggest advertisements, let alone generating and/or displaying alternative advertisements when trick play events (i.e., fast-forward or skip) are detected during playback of recorded advertisements.

AF U.S. 6,408,128

*Relevance:*

Discloses being able to manipulate the viewing of a particular program to skip portions, replay portions or change angles by application of commands. The commands cause the player to jump to different portions of the prerecorded media. The portions of the media may have been flagged when distributed or may be flagged by the subscriber.

*Independent claims 1, 55 and 99* (directed to displaying alternative ad when trick play event is detected):

Specific claim elements not disclosed or suggested include: detecting the trick-play event during playback of a recorded advertisement; and displaying the alternative advertisement to the subscriber.

*Independent claim 70* (directed to generating an alternative ad by applying processing rules to recorded ad):

Specific claim elements not disclosed or suggested include: receiving processing rules; and generating the alternative advertisement by applying the processing rules to the recorded advertisement.

***Remarks:***

Discloses being able to manipulate the viewing of a particular program to skip portions, replay portions or change angels by application of commands. The commands cause the player to jump to different portions of the prerecorded media. The portions of the media may have been flagged when distributed or may be flagged by the subscriber.

**BA "The Implications of Personal TV, Streaming Media and VoD on the Advertising Industry", by Peter Horsemann of Axcent Media AG, March 9, 2001**

European Group of Television Advertising Report "Interactivity and advertising" Working Party  
(taken from [www.cgta.com/pages/egta02\\_4\\_interactivity.html](http://www.cgta.com/pages/egta02_4_interactivity.html))

***Relevance:***

Discloses impacts on advertising caused by the PVR and offers potential solutions including new types of ads and disabling fast-forwarding of ads.

*Independent claims 1, 55 and 99* (directed to displaying alternative ad when trick play event is detected):

Specific claim elements not disclosed or suggested include: detecting the trick-play event during playback of a recorded advertisement; and displaying the alternative advertisement to the subscriber.

*Independent claim 70* (directed to generating an alternative ad by applying processing rules to recorded ad):

Specific claim elements not disclosed or suggested include: receiving processing rules; and generating the alternative advertisement by applying the processing rules to the recorded advertisement.

***Remarks:***

Does not disclose or suggest detecting trick play events during viewing of recorded advertisements and in fact discloses that the initiation of a trickplay event (i.e., fast-forward or skip) during viewing of a commercial shall not be permitted. As such, does not disclose generating and/or displaying alternative advertisements during these events.

**Comments:**

For the foregoing reasons, Applicant respectfully submits that the petition be granted and that the above noted application receive accelerated processing.

If the Special Processing Examiner believes that a conference would be of value in expediting the processing of this Petition, the Special Processing Examiner is hereby invited to contact the undersigned attorney to set up such a conference.

Respectfully submitted,

  
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Douglas J. Ryder, Esquire  
Reg. No. 43,073

Date: 7/3/02

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